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10/764,788	01/26/2004	Edward L. Gibbs	016	9762
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GARY PETERSON 211 N. ROBINSON AVE., SUITE 450 OKLAHOMA CITY, OK 73102			EXAMINER MACARTHUR, VICTOR L	
			ART UNIT 3679	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/764,788

Applicant(s)

GIBBS, EDWARD L.

Examiner

Victor MacArthur

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 31-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/20/05 5/21/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-30, drawn to a fence, classified in class 256, subclass 23.
- II. Claims 31-34, drawn to a post, classified in class 52, subclass 40.
- III. Claims 35-41, drawn to a method of making a fence, classified in class 29, subclass 428.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the fence of claims 1-30 can use a solid post (rather than a tubular post). The subcombination has separate utility such as a support for a road sign (rather than a fence).

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Inventions III and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the

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product as claimed can be made by another and materially different process such as a process including a step of bolting a second anchor to the side of a hard substrate (rather than surrounding a portion of the second anchor with a hard substrate).

Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group I, restriction for examination purposes as indicated is proper.

Inventions III and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as a process including the step of assembling a road sign (rather than assembling a fence).

Because these inventions are distinct for the reasons given above and the search required for Group III is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Gary Peterson on 8/22/2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

The petition filed on 5/25/2005 requesting priority as a CIP of U.S. Patent application 10/306,125 and provisional U.S. Patent Application 60/370,372 is granted. Applicant has complied with all of the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as is detailed in 37 CFR 1.78.

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation “first anchor slot sized to clearly receive one of the first pair of anchors therethrough” and the “membership” limitations throughout claims 9-20 (see 35 USC § 112 rejection below) must be clearly shown or the feature(s) canceled from the claim(s). Note that anchor slots (212, 214) as seen in figure 17 do not appear to be sized to clearly receive the anchors (270) as seen in figure 18 therethrough. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

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renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

- The first paragraph of the specification should be amended to note that Application Serial Number 10/306,125 has been issued as U.S. Patent 6,874,767.
- The specification should be amended to provide proper antecedent basis for the limitation "membership" as recited throughout claims 9-20; or delete the limitation from the claims. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Also note the 35 USC §112 rejection below regarding a similar issue.

Appropriate correction is required.

### ***Claim Objections***

Claims 1, 9 and 14 are objected to because of the following informalities:

- The phrase "first end" (lines 20-21 of claim 1) appears to be a typographical error and should be replaced with --second end-- to conform to the applicant's disclosure.

Claims 9 and 14 are similarly objected to.

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- The “membership” phraseology recited throughout claims 9-20 is not recited in the specification. Furthermore, it is unclear which drawing elements, if any, are represented by the structural relationship described by the above-mentioned phraseology.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears that the applicant is attempting to claim numerous embodiments at once by referring to a single element with varying terminology so as to create numerous confusing double inclusions. For instance, claim 10 recites, “the membership of the first plurality of posts is the same as the membership of the second plurality of posts” (lines 1-3 of claim 10). It is unclear how a second plurality of elements can be distinct from a first plurality of elements, thus earning the separate labels “first” and “second”, while still being of the same “membership”. The overlapping membership and percentage of membership limitations used elsewhere throughout claims 9-20 is similarly unclear. Furthermore, the limitations “the membership” (line 1 of claim 10 and elsewhere) and “the shared membership” (line 1 of claim 20) lack proper antecedent

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basis. These claims have been rejected in view of the prior art as best understood by the examiner.

If the applicant is attempting to claim three separate embodiments of post and cable system configurations then the applicant should do so in a manner that does not require the presence of confusing double inclusions (i.e. elements recited as being both separate and not separate at the same time). The applicant is strongly urged to contact the examiner prior to any subsequent amendment in order to discuss proper claim format.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 21-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Crisp (U.S. Patent 4,979,817).

Claim 1. Crisp discloses (figs.1-5) a fence, comprising: a first plurality of posts (14', 14, 12, additional 14', 14 not shown but required by col.3, ll.30-45 at both ends of each 100ft cable section); a first rail system (22) supported by the first plurality of posts so as to form a barrier between each adjacent pair of the first plurality of posts, the first rail system having a longitudinal internal recess (recesses receiving 24) formed therein and a first end (left end of 22 denoted as 22A) and an opposed second end (right end of each 100ft section of 22 not shown but required by col.3, ll.30-45); and a first rail cable assembly (24) comprising: a first cable (24)



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having a first end (left end of 24) and opposed second end (second end of 100ft section of 24 not shown but required by col.3, ll.30-45), the first cable extending within at least a portion of the internal recess of the first rail system; a first anchor substrate (28') situated adjacent the first end of the first rail system which anchors the first cable adjacent its first end; and a second anchor substrate (additional 28' to right of 100 ft section 24, not shown but required by col.3, ll.30-45) situated adjacent the second end of the first rail system which anchors the first cable adjacent its second end.

Claim 2. Crisp discloses that the first rail cable assembly further comprises: a first anchor (32) at least partially embedded in the first anchor substrate and attached to the first cable adjacent its first end; and a second anchor (second 32 as required by col.3, ll.30-45) at least partially embedded in the second anchor substrate and attached to the first cable adjacent its second end.

Claim 3. Crisp discloses that the first plurality of posts comprises: a first terminal post (14') and a spaced second terminal post (second 14' to the right of 12, not shown but required by col.3, ll.30-45); and at least one intermediate post (12), each intermediate post situated between the first and second terminal posts, each intermediate post having a first cable passageway (passageways in 12 receiving 22) extending therethrough; and in which the first cable is further characterized as extending through the first cable passageway of each intermediate post.

Claim 4. Crisp discloses that the first plurality of posts comprises: a first terminal post (14') supported by the first anchor substrate; a second terminal post (second 14' to the right of 12, not shown but required by col.3, ll.30-45), spaced from the first terminal post and supported

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by the second anchor substrate; and at least one intermediate post (12), each intermediate post situated between the first and second terminal posts.

Claim 5. Crisp discloses that the first cable extends through the entire first rail system (col.3, ll.30-45).

Claim 6. Crisp discloses that each of the terminal posts is at least partially filed with ballast (concrete, col.3, ll.5-10) and in which the first cable is embedded within the ballast at and adjacent each of its ends (as seen in figure 4).

Claim 7. Crisp discloses a first anchor (portion of 24 embedded and anchored within 14) attached to the first cable adjacent its first end, the first anchor situated within the first terminal post and at least partially embedded within the ballast therein; and a second anchor (second portion of 24 embedded within the second 14 not shown but required by col.3, ll.30-45) attached to the first cable adjacent its second end, the second anchor situated within the second terminal post and at least partially embedded within the ballast therein.

Claim 8. Crisp discloses that the first terminal post is further characterized as having a first anchor slot (slot in 14 receiving 24) formed in a lateral portion thereof, the first anchor slot sized to closely but clearly receive the first anchor therethrough, and in which the second terminal post is further characterized as having a second anchor slot (slot in second 14 receiving 24) formed in a lateral portion thereof, the second anchor slot sized to closely but clearly receive the second anchor therethrough.

Claim 21. Crisp discloses (figs 1-5) a fence kit (fig.2), comprising: a plurality of posts (50); a plurality of rails (56, 58), each rail having a longitudinal internal recess (recess within 56 and 58) formed therein within which a cable may extend; a first cable (bottom 24) extensible

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within the internal recess of each rail; and a first pair of anchors (anchors 42 at ends of bottom 24 which are present in the figure 2 embodiment as described in col.4, ll.56-60), each anchor attachable to the first cable.

Claim 22. Crisp discloses that each of the rails is situated in a separate panel (left panel and right perpendicular panel), each panel comprising plural parallel rails upon which a plurality of pickets (62) is transversely positioned.

Claim 23. Crisp discloses that the plurality of posts comprises at least one intermediate post (50), each intermediate post having a cable passageway (passageway in 50 receiving bottom rail) extending therethrough, the cable passageway sized to permit clearing passage of the first cable.

Claim 24. Crisp discloses that each intermediate post is further characterized as having a second cable passageway (passageway in 50 receiving second rail from bottom), spaced from the first cable passageway, and further comprising: a second cable (second cable from bottom) extensible through the second cable passageways of the posts and within the internal recess of each rail; and a second pair of anchors (anchors 42 at ends of second 24 from bottom which are present in the figure 2 embodiment as described in col.4, ll.56-60), each anchor attachable to the second cable.

Claim 25. Crisp discloses that the plurality of posts comprises at least one tubular terminal post (post 14 which is present in the figure 2 embodiment as described in col.4, ll.56-60).

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Claim 26. Crisp discloses that the terminal post is characterized by an elongate lateral portion (lateral portion of 14) having a first anchor slot (40 as seen in fig.3) formed therein, the first anchor slot sized to clearly receive one of the first pair of anchors therethrough.

Claim 27. Crisp discloses that the first anchor slot is selectively closable (functional) by a slot cover (in that it is a slot that is fully capable of receiving a slot cover).

Claim 28. Crisp discloses that the slot is selectively closable (functional) by a slot cover that has a cable opening formed therein, sized to clearly receive all or part of the first cable (in that it is a slot that is fully capable of receiving a slot cover with such a cable opening formed therein).

Claim 29. Crisp discloses that each anchor is characterized by a cross-sectional profile (cross-sectional loop profile of 42) having dimensions, which substantially exceed the cross-sectional dimensions of the first cable.

Claim 30. Crisp discloses that the terminal post is characterized by an elongate lateral portion (lateral portion of 14) having a first anchor slot (slot in 14 receiving 24) formed therein, the first anchor slot sized to clearly receive one of the first pair of anchors therethrough.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-20. Figure 1 of Crisp shows a fence with a length of about 200 ft (since each cable is about 100 ft, col.3, ll.30-35). The cutaway ends of the figure 1 assembly imply that the fence continues for a length greater than that expressly shown in figure 1, however the exact length is not expressly stated. Crisp states that the fence surrounds property to secure larger areas such as diplomatic embassies (col.1, ll.10-15; 40-45 and col.2, ll.59-62). One of ordinary skill in the art at the time the invention was made would have easily recognized that surrounding the perimeter of an area such as a diplomatic embassy would require repeatedly duplicating the figure 1 assemblage of Crisp to obtain a fence long enough to surround an embassy. It has generally been recognized that duplicating the components of a prior art device is a design consideration within the skill of the art. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to repeatedly duplicate the figure 1 fence portion of Crisp, for the disclosed benefit of surrounding a large area such as an embassy, since such practice is a design

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consideration within the skill of the art. Such modification would necessarily result in the marked-up duplicated version of figure 1 shown above, wherein in addition to the first plurality of posts (300-600) there is a second plurality of posts (700-1000) and third plurality of posts (1100-1400); and in addition to the first rail system (bottom 24) there is a second rail system (middle 24) and third rail system (top 24). This modified version of Crisp suggests all of the limitations of claims 9-20 as best understood by the examiner. See 35 U.S.C. 112 rejection above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Referring to cable fences:

Dowell U.S. Patent 1,848,246

Winston U.S. Patent 4,075,473

Wun-Chung U.S. Patent 4,819,916

Ver Loren Van Themaat U.S. Patent 4,920,331

Lembo U.S. Patent 5,685,665

Benedict U.S. Patent 5,944,443

Kazuyoshi JP 2001-342751

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085.

The examiner can normally be reached on 8:30am - 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.



VLM

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DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600